

Application No. 09/607,313

REMARKS

The Examiner's attention to the present application is appreciated.

In the Office Action dated September 7, the Examiner rejected claim 30 under 35 U.S.C. 103(a) as being unpatentable over the brochure on "Paint Pop" product in view of Nichels and Chan. That rejection is traversed.

Chan does not relate to a dipping candy. The Examiner asserted that Chan teaches a candy with an edible handle portion. Applicant has amended independent claim 30 to recite that the handle portion is "a completely edible handle portion". Support for this amendment can be found in the specification as originally filed, on page 5, lines 12-14. Chan requires sleeve 20 which is a non-edible portion - "The complete lollipop assembly 1 includes a plastic sleeve 20 surrounding the stick 6" (see Col. 4, lines 4 and 5 of Chan). A handle is known to those skilled in the art as a thing which a person contacts and grasps. Chan does not teach that a person contacts and grasps the sticky gum handle of that invention. Rather, Chan teaches that a person grasps the plastic sleeve. As such, the "handle" of Chan is arguably only the plastic sleeve portion and thus has no edible portion whatsoever. To clarify this distinction, independent claim 30 has been amended such that it is directed to a confectionery set wherein a handle of a paintbrush is completely edible. As such, no combination of the prior art describes all the elements of Applicant's claimed invention.

The post-facto combination of the prior art references of Nichels, Chan, and the brochure on the "Paint Pop" product (the "Paint Pop") would not have been made by those skilled in the art without having prior knowledge of Applicant's invention. In other words, there is no motivation to make the combinations. Chan describes a product a focus of which is ease in manufacturing and which does not have the elements or interesting/marketable features of the present invention. Nichels describes a product that is not edible nor in the same field as the present invention. The "Paint Pop" product also does not have the features of the present invention.

One would combine these three very different references if, as the Examiner does, one would have prior knowledge of Applicant's invention. As such, those skilled in the art at the time when

Application No. 09/607,313

Applicant's application was filed would never have looked to the three references upon which the Examiner currently relies to reject Applicant's independent claim 30 because the three references are so different that they cannot realistically be combined. For example, the Paint Pop teaches a roller-shaped candy device wherein a non-edible handle portion is connected to a non-edible rotating interface portion which is fixedly secured to an edible candy portion. The devices of Nickels and Chan, alone or in combination, do not disclose a non-edible rotating interface. Applicant's invention also lacks that prominent feature of the Paint Pop reference. The present rejection is the type of highly selective post-facto type of rejection that has been held improper by the court in *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, (Fed.Cir.1998). In that case, at page 546, the court stated:

"Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor."

Here, the Examiner appears to be engaging in the selective type of culling addressed by the court in that case.

The combination of the Paint Pop with Chan and Nickels to reject claim 30 is further contrary to the common law established by the court in *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In that case, the court held that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." In essence, that case relied upon a change to a device wherein Patentee taught that the device required rigidity for operation, whereas the claimed invention required resiliency. The court further held that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." (*Id.* at 813).

Application No. 09/607,313

In the present application, the principal operation of the Paint Pop reference relies upon the rolling action of the paint roller. Combining that reference in such a manner that results in Applicant's invention, which does not have any rolling action, changes the principal operation of the Paint Pop reference and thus is improper. The Examiner's combination which requires the rolling action of the Paint Pop reference to be converted to a completely dissimilarly-shaped device which is fixed and does not rotate is an even more substantial change to the prior art than the rigidization of an otherwise flexible member as addressed by the court in *In re Raffi*. Nickels discloses a device in an entirely different field. Therefore, combining any of the references would not result in the present invention.

In addition to the above, Chan teaches a lollipop which has an edible stick encased within a plastic sleeve wherein the edible stick is made from candy chips and gum chips. Chan does not teach a "paint brush having a completely edible handle portion and an edible bristle portion" as does Applicant. More importantly, Chan does not teach a "flowable confectionery disposed within a lid-enclosed container", as is claimed by Applicant. Any combination which relies upon the teachings of Chan is further inappropriate because Chan teaches away from Applicant's dipping candy. This is because Chan does not relate to a dipping candy, and also because Chan is a plain lollipop with an edible stick encased within an plastic sleeve and does not have a completely edible handle. Nickels fails to teach a "paint brush having a completely edible handle portion and an edible bristle portion" as does Applicant.

The Examiner's rejection relies upon vague assertions about an undocumented state of the art. For example, on page 3 of the Office Action, the Examiner stated "it would have been obvious for one to include a lid when the product is made in the shape of a paint can to prevent the content inside the container from falling out." The Examiner makes this assertion even though each and every one of the three prior art references relied on by the Examiner lacks this allegedly obvious feature.

What a person skilled in the art would get if he or she attempted to combine these three very different references might be for example, a roller device with a bubblegum chip stick encased in a plastic sleeve, a non-edible rotating interface, and an edible roller.

Therefore, claim 30 is believed to be allowable.

Page 9 of 10

Application No. 09/607,313

Applicant has added new dependent claims 32 through 42 to better define the scope of the present invention. Because they depend from independent claim 30, they too are believed to be allowable.

New independent claims 49 and 51 are also directed to a confectionery set comprising a paint brush having a "completely edible handle" portion and thus are also allowable over the prior art. New independent claim 43 is directed to a confectionery set comprising "a completely edible coatable utensil". Independent claim 43 is thus also allowable over the prior art. Because dependent claims 44-48 depend from allowable claim 43, they are also allowable. Support for these new claims can be found in the specification as originally filed, on page 5, lines 12-14.

In view of the above amendments and remarks, it is submitted that all grounds of rejection and objection have been avoided and/or traversed. It is believed that the case is now in condition for allowance and same is respectfully requested.

If any issues remain, or if the Examiner believes that prosecution of this application might be expedited by discussion of the issues, the Examiner is cordially invited to telephone the undersigned attorney for Applicant at the telephone number listed below.

Authorization is given to charge payment of any additional fees required, or credit any overpayment, to Deposit Acct. 13-4213.

Date: 1/9/05

By:

Respectfully submitted,


Vidal A. Oaxaca, Reg. No. 44,267
Direct line: (505) 998-1501

PEACOCK MYERS, P.C.
Attorneys for Applicant(s)
P.O. Box 26927
Albuquerque, New Mexico 87125-6927

Telephone: (505) 998-1500
Facsimile: (505) 243-2542
Customer No. 005179

G:\AMDS\Impact\313-OA Resp Dec. 2005.doc

Page 10 of 10